

### **REMARKS**

By this Amendment, Applicants amend claims 1, 4, 7, 8, and 14. Claims 1, 2, and 4-14 remain pending in the application.

In the Office Action,<sup>1</sup> the Examiner rejected claims 1, 2, and 4-14 under 35 U.S.C. § 103(a) as being unpatentable over Kolls (U.S. Patent No. 6,601,038) in view of Rivalto (U.S. Patent No. 5,482,139). Applicants respectfully traverse the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 1, as amended, recites a "method of providing advertisements to an automated service machine over a network" including, among other steps, "selecting ... an electronic coupon based upon the consumer history of the user" and "delivering the selected electronic coupon to the smart card."

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants note that the Kolls system discloses “[t]he selection of marketing advertisements can be ... in accordance with a customer profile (individual or by group type).” See col. 32, lines 25-27. In that regard, according to the Kolls system, “[a]n individual customer profile is a profile for an individual person” and a “group profile is ... specific to a group.” See col. 32, lines 30-32. Furthermore, according to the Kolls system, printers 612A and 612B may be used for coupon printing, among other purposes. See col. 16, lines 31-57. However, Kolls does not teach or suggest “selecting ... an electronic coupon based upon the consumer history of the user” (emphasis added). Furthermore, while the Kolls system may “add or subtract value (monetary/credit/units) from a smart card” (see col. 18, lines 41-66), Kolls also does not teach or suggest “delivering the selected electronic coupon to the smart card,” as recited in claim 1. Accordingly, Kolls does not teach or suggest all of the elements of claim 1 for at least these reasons.

Moreover, Rivalto does not make up for the deficiencies of Kolls. In the Office Action, the Examiner contends Rivalto teaches “a record of [a] particular customer’s overall purchasing history being tracked for targeting customers for product marketing promotion.” See pages 2-3. While Applicants do not necessarily agree with the Examiner’s allegations, Rivalto does not teach or suggest “selecting ... an electronic coupon based upon the consumer history of the user” and “delivering the selected electronic coupon to the smart card.” Since Rivalto does not compensate for the deficiencies of Kolls, the applied references, taken individually or in combination, fail to disclose or suggest all of the elements of claim 1. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 7, 8, and 14, while of a different scope from claim 1 and from each other, have been amended to include recitations similar to those discussed above with regard to claim 1. Accordingly, Kolls and Rivalto, whether taken individually or in combination, do not disclose or suggest claims 7, 8, and 14 for at least the same reasons discussed above in connection with claim 1. Therefore, the Examiner should withdraw the rejection of claims 7, 8, and 14 under 35 U.S.C. § 103(a).

Claims 2 and 4-6 depend from claim 1 and claims 9-13 depend from claim 8 and, therefore, are neither disclosed nor suggested by Kolls and Rivalto, whether taken individually or in combination, at least due to their dependence. Accordingly, the Examiner should also withdraw the rejection of claims 2, 4-6, and 9-13 under 35 U.S.C. § 103(a).

#### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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